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Remarks

Applicant hereby adds claims 36-44. Accordingly, claims 1-44 are pending in the present application.

Claims 1-4, 6-7, 11-21, 24-28, 30-32 and 35 stand rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 4,251,129 to Suzuki et al. Claims 5, 8-10, 22-23, 29 and 33-34 stand rejected under 35 USC 103(a) for obviousness over Suzuki.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 2), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to the anticipation rejection of claim 1, the Office at page 2 of the Action identifies references 1-4 of Fig. 1 as allegedly disclosing the claimed optical scanning device. References 5, 7, 9 are identified by the Office as allegedly disclosing the claimed reflectors. Applicant respectfully submits the teachings relied upon by the Office fail to disclose or suggest positively-recited limitations arranged as recited in claim 1.

More specifically, claim 1 recites reflectors individually configured to *pass one of the input light beam and a light beam reflected by the scanning device* and configured to reflect *another light beam reflected by the scanning device*. The references 5, 7, 9 of Suzuki fail to disclose or suggest *passage of either of the input light beam or the light beam reflected by the scanning device in combination with the reflection of the another light beam reflected by the scanning device*.

In particular, as illustrated in Fig. 1, references 5, 7, 9 receive light beams which have been reflected by mirror 3. Accordingly, references 5, 7, 9 can not permit passage of an input light beam as claimed since the references 5, 7, 9 are not arranged in optical communication to receive an input light beam but permit passage of reflected light beams (P polarized light per col. 4, lines 18+).

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Additionally, none of references 5, 7, 9 encounter plural light beams reflected by the mirror 3. As shown in Fig. 1, there are no plural reflections of light beams provided by the mirror 3 (i.e., once a given beam is reflected by mirror 3, it is thereafter directed to detector 18 or assembly 24). Accordingly, none of references 5, 7, 9 are configured to pass a light beam reflected by the scanning device and reflect another light beam reflected by the scanning device.

Additionally, references 5 and 7 do not disclose reflection of a light beam reflected by the scanning device, but to the contrary, reflect light beams reflected by the wafer 13 per col. 4, lines 26+. Indeed, references 5 and 7 are configured to transmit P polarized light and reflect S polarized light. Mirror 3 is disclosed as reflecting the P polarized light and light reflected by wafer 13 is rotated by 90 degrees by plate 41 to become the S polarized light which is reflected by references 5, 7. Accordingly, the only light reflected by references 5 and 7 is reflected by the wafer 13 as opposed to the mirror 3. Accordingly, references 5 and 7 fail to disclose or suggest the reflectors of claim 1 configured to reflect a light beam reflected by the scanning device.

Furthermore, Applicant has electronically searched Suzki and have failed to uncover any teachings of a *photoconductor* or reflection of a received light beam towards a photoconductor as recited in claim 1.

As set forth above, numerous limitations arranged as recited by claim 1 are not disclosed nor suggested by the prior art. Applicant respectfully submits the anticipation rejection of claim 1 is improper for the above-mentioned compelling reasons and claim 1 is in condition for immediate allowance.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 14, references 5, 7, 9 of Suzki are located downstream of mirror 3 and accordingly receive light reflected by mirror 3 after reflection by the mirror. Applicant has failed to uncover in Suzki any teaching or suggestion of the one of the reflectors configured to permit passage of an input light beam before being reflected using the scanning device. Positively-recited limitations of claim 14 are not disclosed nor suggested by the prior art and claim 14

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is allowable for at least this reason.

Referring to independent claim 15, the optical scanner apparatus comprises the *beam direction system disposed between the light source and the scanning device to permit passage of both the input light beam and the corresponding output light beam reflected by the scanning device towards the photoconductor.* As shown in Fig. 1 of Suzuki, only a *condenser lens 2* is illustrated as disposed between laser 1 and polygon mirror 3. Applicant has failed to uncover any teachings in the prior art of condenser lens 2 being configured to rectify scanning errors as claimed. Further, Applicant has failed to uncover any teachings of lens 2 passing light reflected by the mirror 3. Suzuki fails to disclose or suggest the claimed *beam direction system disposed between the light source and the scanning device and configured to rectify scanning errors and to permit passage of both the input light beam and the corresponding output light beam reflected by the scanning device.* Numerous positively-recited limitations of claim 15 are not disclosed nor suggested by the prior art and claim 15 is allowable for at least this reason.

Applicant has identified herein numerous claimed limitations of claim 15 which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable.* Applicant respectfully requests clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if claim 15 is not found to be allowable.

In particular, Applicant respectfully requests identification of teachings which are considered to disclose the beam direction system and the above-recited limitations with respect thereto so Applicant may appropriately respond during the

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prosecution of the present application.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 20, Applicant has failed to uncover any teaching or suggestion of the claimed photoconductor means. Applicant has electronically searched Suzki and has failed to uncover any recitation to a photoconductor or any other teaching which may be fairly considered to disclose photoconductor means as claimed. The Office fails to identify any teachings which allegedly disclose the claimed photoconductor means recited in claim 20. The photoconductor means is not taught nor suggested by the prior art and claim 20 is allowable for at least this reason.

Further with respect to claim 20, *references 5 and 7 of Suzki are disclosed as being configured to pass light beams of P polarized light reflected by mirror 3 and reflect light beams of S polarized light which are reflected by the wafer 13 and not the mirror 3*. The reflector means for *reflecting a light beam reflected by the scanning means* is not disclosed nor suggested by the prior art and claim 20 is allowable for at least this reason. References 5 and 7 are clearly disclosed as transmitting P polarized light reflected by the mirror 3. The reflector means of claim 20 is not disclosed nor suggested by the prior art and claim 20 is allowable.

If claim 20 is not allowed, Applicant respectfully requests issuance of a *non-final Action* in accordance with the CFR to identify teachings of the prior art which allegedly disclose at least the above-recited limitations so Applicant may appropriately respond during the prosecution of the present application.

Referring to claim 21, Applicant has failed to uncover any teachings in the prior art of the claimed photoconductor and claim 21 is allowable for at least this reason.

In addition, *references 5 and 7 of Suzki are disclosed as passing light beams reflected by mirror 3 and reflecting light beams of S polarized light which are reflected by the wafer 13 and not the mirror 3*. The reflectors of the claimed *beam direction system configured to reflect a light beam reflected by the scanning device* are not disclosed nor suggested by the prior art and claim 21 is allowable for at

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least this reason.

If claim 21 is not allowed, Applicant respectfully requests issuance of a *non-final Action* in accordance with the CFR to identify teachings of the prior art which allegedly disclose at least the above-recited limitations so Applicant may appropriately respond during the prosecution of the present application.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 24, light emitted by laser 1 of Suzki is reflected once by mirror 3. However, the method of claim 24 recited first reflecting the input light beam using the scanning device and thereafter second reflecting the light beam onto the photoconductor using the scanning device. Suzki fails to disclose the first and second reflectings using the scanning device as positively claimed and claim 24 is allowable for at least this reason. More specifically, *light is only reflected once by mirror 3 of Suzki*.

Further, Applicant has electronically searched and failed to uncover any teachings in the prior art of a photoconductor or *reflecting a light beam onto a photoconductor* as positively claimed. Positively recited limitations of claim 24 are not disclosed nor suggested by the prior art and claim 24 is allowable for at least this reason.

If claim 24 is not allowed, Applicant respectfully requests issuance of a *non-final Action* in accordance with the CFR to identify teachings of the prior art which allegedly disclose at least the above-recited limitations so Applicant may appropriately respond during the prosecution of the present application.

The claims which depend from independent claim 24 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 25, the prior art fails to disclose or suggest passing an input light beam through a first reflector before the first receiving the input light beam by the scanning device as positively claimed. Claim 25 is allowable for this additional reason.

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Referring to dependent claim 30, the prior art fails to disclose or suggest *passing an input light beam through a first reflector and the first and second optical devices before first reflecting the input light beam using the scanning device.* Positively recited limitations of claim 30 are not disclosed nor suggested by the prior art and claim 30 is allowable for this additional reason.

Referring to claim 32, Applicant has fail to uncover any teachings in Suzki of *directing light to a photoconductor.* Claim 32 is allowable for at least this reason. Also, Suzki discloses reflection of light using mirror 3 and a wafer 13. Mirror 3 only reflects received light once towards system 24 or detector 18. Accordingly, Suzki fails to disclose or suggest *first reflecting light using the reflection device, redirecting the light reflected from the reflection device to the reflection device, and second reflecting the redirected light to the photoconductor using the reflection device.* Numerous positively recited limitations of claim 32 are not disclosed nor suggested by the prior art and claim 32 is allowable for at least this reason.

If claim 32 is not allowed, Applicant respectfully request issuance of a *non-final Action* in accordance with the CFR to identify teachings of the prior art which allegedly disclose at least the above-recited limitations so Applicant may appropriately respond during the prosecution of the present application.

The claims which depend from independent claim 32 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

In addition, Applicant respectfully submits the obviousness rejections over Suzki are improper. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

The Office on page 4 states that inclusion of circularly polarized light is obvious for the purpose of having higher inherent isolation of the light beams. Applicant respectfully submits the alleged motivational rationale is insufficient and

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the Office has failed to present a proper 103 rejection for at least this reason.

More specifically, Suzki discloses a presumably operable system to achieve the results for which it was designed. Applicant has failed to uncover any teachings in Suzki of concern or problems with respect to isolation of light beams. Further, there is no evidence of record that baldly including "circularly polarized light" will increase isolation of the light beams in the specific arrangement of Suzki or that such would result in improved performance to motivate one to modify Suzki in the first instance.

The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01(8th ed., rev. 2) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The motivation for forming the combination must be something *other than hindsight reconstruction based on using Applicant's invention as a road map* for such a combination. See, e.g., *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present application, there is no impetus to modify Suzki and Applicant respectfully submits the Office has failed to establish a proper 103 rejection. Preferably, the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993)

Applicant respectfully requests withdrawal of the obviousness rejections of the claims for at least these compelling reasons.

Applicant hereby adds new claims 36-44 which are supported at least by the teachings in Figs. 6-9B and the associated specification teachings thereof.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).


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Respectfully submitted,

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